



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,875	07/19/2001	Jens Ehlers	1998/G-021	8024

23416 7590 03/20/2003

CONNOLLY BOVE LODGE & HUTZ, LLP
1220 N MARKET STREET
P O BOX 2207
WILMINGTON, DE 19899

EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 03/20/2003

//

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,875

Applicant(s)

EHLERS ET AL.

Examiner

Rob Rábago

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g. 6) ☐ Other: .

DETAILED ACTION

1. This application filed under 35 USC 371 contains two sets of application papers. The first set contains pages 1-11. The second set contains pages 1-9 each marked "AMENDED SHEET", and therefore these amended pages have replaced prior pages 1-9. Amended pages 8-9 contain claims 1-7 only, and page 10 contains claim 11 only. Accordingly, the pending claims are 1-7 and 11. Claim 11 has been renumbered as claim 8 as required by 37 CFR 1.126.

Applicants are advised that amended claims referred to as 9 and 10 in the preliminary amendment filed 7/19/2001 have not been entered because no claims of these numbers are currently pending in this application. Only pending claims may be amended.

Claim Objections

2. Claims 1-4 are objected to because they have been written in a confusing columnar format which is difficult to read. Should these claims mature into a patent, the lines of each claim will likely be printed as a regular linear sentence, resulting in numerous phrases being out of order. Each claim should be redrafted as a regular linear sentence.

3. Claims 7 and 8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be phrased in the alternative. In claim 7 (and

claim 8 as dependent thereon) the phrasing "one or more of claims 1-6" does not satisfy the requirement. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process of preparing a homopolymer or a copolymer, does not reasonably provide enablement for process of preparing a homopolymer and a copolymer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In view of the fact that the claim recites, in one embodiment, the making of a homopolymer or a copolymer, the embodiment of a homopolymer and a copolymer is understood to mean that both a homopolymer and a copolymer are being made simultaneously in the same polymerization method. There is nothing in the specification, either by discussion or by example, which would enable the ordinary skilled worker to practice such a method.

6. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons.


(a) Neither the specification nor the claims provides any definition for either the meaning or scope of "irregular" as recited in claims 1-8. All polymerization processes which produce particulate product will produce polymer particles which are irregular to some degree, typically in either size or shape, yet the instant application has not provided a description of the type of irregularity intended. Furthermore, the degree to which the particles are irregular may vary immensely, and there is no basis to determine what degree of irregularity applicants consider to be within the scope of their claims.

(b) The use of "and/or" in claims 1-8 renders unclear whether the word "and" is meant to recite an in-situ blend of homopolymer and copolymer. The specification appears to be devoid of any description thereof.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rábago whose telephone number is (703) 308-4347. The examiner can normally be reached on Monday - Friday from 7:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

RR 
March 17, 2003

Rob Rábago
Examiner
Art Unit 1713

